



05 MAY 2006

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In re Application of	:	
RUSSELL et al.	:	
Application No.: 10/522,809	:	DECISION
PCT No.: PCT/AU03/00393	:	
Int. Filing Date: 31 March 2003	:	
Priority Date: 31 July 2002	:	
Attorney Docket No.: 034164.002	:	
For: ANIMATED MESSAGING	:	

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 28 March 2006 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 31 March 2003, applicants filed international application PCT/AU03/00393, which designated the United States and claimed a priority date of 31 July 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 05 February 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 31 January 2005.

On 31 January 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and an assertion of small entity status.

On 09 June 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 10 November 2005, applicants filed a submission which included, *inter alia*, a petition/fee for a four month extension of time, a declaration of inventors, and the surcharge under 37 CFR 1.492(e) for providing the declaration of inventors later than thirty months from the priority date.

On 23 November 2005, applicants filed a "DECLARATION OF NICHOLAS RUSSELL IN SUPPORT OF ONE CO-INVENTOR SIGNING ON BEHALF OF ANOTHER".

On 30 January 2006, a decision treating the submissions filed 10 November 2005 and 23 November 2005 together as a petition under 37 CFR 1.47(a) was mailed dismissing the petition without prejudice. Specifically, it was noted that factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort had not been provided and that a clear statement of the last known address of the missing inventor had not been provided.

On 28 March 2006, applicants submitted the instant renewed petition under 37 CFR 1.47(a) which was accompanied by an appendix which contains various purported e-mails between Nick Russell and Anton Felich.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision mailed 30 January 2006, items (1) and (4) have been met. Item (3) has now been met as well.

Item (2) still has not been met. As noted in the decision mailed 30 January 2006 and in MPEP § 409.03(d), the statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Here, it is not clear that Nicholas Russell has firsthand knowledge of the facts recited in the declaration by him. Statements based on hearsay will not normally be accepted. As to Appendix A, there is no statement by Nicholas Russell verifying that these are copies of e-mails exchanged between himself and Anton Felich. Also, it is suggested in the renewed petition that the reference to "paperwork on the patent" refers to the application papers, which include the specification, claims, drawings, and oath or declaration (as noted in the decision mailed 30 January 2006). However, there is nothing of record to suggest that the papers sent to Mr. Felich included the specification, claims, and drawings. Indeed, the declaration of Mr. Russell indicates that only Declaration and Assignment Forms were sent to Mr. Felich (paragraph 8). As noted in the decision mailed 30 January 2006, to establish a refusal to sign, it is required that the inventor be presented with the application papers (specification, including claims, drawings, and oath or declaration). See MPEP 409.03(d). "It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." MPEP 409.03(d).

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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